

PATENT
IBM Docket No. BLD920000040US1

REMARKS

The claims have been amended by rewriting claims 9, 13, 21, and 25 which have been rewritten in independent form, and claims 30, 32, 34, 35, cancelling non-elected claims 1-5 and claims 6-8, 10-12, 18-20, and 22-24, and submitting new claims 36-37. Claims 9, 13, 14-17, 21, 25, and 26-37 remain in the application.

Applicants respectfully request that the rejection of the claims presented be reconsidered and withdrawn in light of the amendments above and the discussion which follows and that the application be found in condition for immediate allowance.

Confirmation of Election/Restriction

Applicants acknowledge the telephonic election of Group II on October 7, 2003. Group II corresponds to claims 6-35. Applicants intend to file a divisional application relative to the claims of Group I.

Drawing Objections

Figures 2, 3, and 5 are objected to because certain reference numerals, according to the Official Action, are not mentioned in the description.

In response to item 140 of Figure 2, Applicants offer that item 140 can indeed be found in the specification at page 14 at line 11. The sentence there reads: "... the optional local services 135 may include a connection to a telephone network 140, as shown in Fig. 2. . . ." Applicants believe, therefore, that the objection raised in the Official Action should be withdrawn.

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In response to items 45A, 45B, ..., 45N of figure 3, Applicants have amended the written description of the specification.

In response to items 30A, 30B, ..., 30N of figure 3, Applicants have amended the written description of the specification.

In response to item 53 of Figure 3, Applicants offer that item 53 can indeed be found in the specification at page 13 at line 8. The sentence there, starting at line 5 reads: "... The networked multifunction controllers 25A-25n may further communicate and share resources, for example, global remote printers 53,..." Applicants believe, therefore, that the objection raised in the Official Action should be withdrawn.

Abstract Replacement

Although not objected to by the Examiner, Applicants have amended the abstract to shorten it and thereby conforming to Office requirements.

Claim Rejections

The 35 USC §102 Rejections

It is Applicants' understanding that a rejection on the basis of anticipation under 35 USC 102 is appropriate where each element of a claim at issue is found in a single prior art reference. See Kalman v Kimberly-Clark Corp., 218 USPQ 781 at 789, (Fed. Cir. 1983). The requirement is for an element by element comparison of the recited structure, function and operative steps with what is found in the reference sought to be applied. The rejection is proper where such an element by element comparison finds identity for each element within the four corners of the reference.

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It is respectfully submitted that the rejection made in the Official Action falls short of this standard. Further, it is respectfully submitted that no rejection can be framed on the basis of the references cited, whether applied or not, which will support a refusal to allow the claims as presented, without regard for whether that possible rejection is grounded on anticipation under 35 USC 102 or obviousness under 35 USC 103.

Claims 9, 13, 21, and 25

Turning first to Claims 9, 13, 21, and 25, those claims stand rejected (as do all claims presented except for claims 31 and 33) as anticipated by the disclosure of Kobayashi et al., United States Patent 6,246,487 (Hereinafter "Kobayashi"). Applicants respectfully submit that these rejections are improper.

Claims 9, 13, 21, and 25 have been rewritten in independent form and are of original scope. Therefore, these claims have not been substantively amended such as to require a new search.

These claims (9, 13, 21, and 25) recite at least the following bold highlighted elements and limitations which, when taken in combination, Applicants believe are neither disclosed nor suggested in Kobayashi:

... a **memory coupled to and housed with said controller;**
said control program when executing on said controller
further enabling a user to **store a database of address**
information in said memory and to selectively access one
of said database of address information stored in said
memory and a **second database of address information**
stored remotely from said controller and accessible
through said first network interface. . . .

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This expressly recited claim language requires two databases, one local database stored in a memory which is housed with the controller, and a second database which is remote from said controller.

Contradistinctively, Kobayashi discloses only a single database which is accessible only within the composite apparatus of Kobayashi. Kobayashi teaches a composite apparatus 1 which is comprised of a server 2 and a multifunction unit 3. It is the server 2 which houses the telephone directory database which is accessible from an operation panel of the multifunction device 3. It appears that the Examiner is asserting that the database is remote because a LAN connection couples the protocols of the server 2 and the multifunction unit 3 (see the Official Action on the last sentence of Page 5). Applicants respectfully assert that whether the server housing the database is considered to be remote or local to the multifunction unit is irrelevant because only one is disclosed and it can't be both local and remote. Note that although several composite apparatus are disclosed in Kobayashi, see Figure 9, access to the telephone directory database is always confined to within the composite apparatus (a composite apparatus being a server 2 paired with a specific multifunction unit 3). There is no disclosure in Kobayashi of an operating panel initiated telephone directory request which is serviced by a composite apparatus which is other than the composite apparatus in which the operating panel resides. In other words, there are no intra-composite-apparatus telephone database requests disclosed in Kobayashi as there are other intra-apparatus requests such as print, and notification.

Indeed, to meet the requirements of the claim as to "... a **memory** coupled to and housed with said controller; ..." on which memory a database is stored, it seems unreasonable to Applicants to call this database a remote database since it must be housed with the controller.

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The cancellation of claims 7 and 8, and the like, are not to be taken as a capitulation that Kobayashi discloses a locally housed database and a remote database.

For the reasons stated above, claims 9, 13, 21, and 25 do not read on the disclosure of Kobayashi. To find anticipation of a patent claim, the claim at issue must "read on" a prior art reference. See *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985). Therefore, these claims are not anticipated by Kobayashi. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of two databases, one non-remote database stored in a memory which is housed with the controller, and a second database which is remote from said controller.

Even if one were to take to more liberal view that the Kobayashi patent might be a reference for an obviousness rejection, support necessary for such a rejection is absent from the Official Action and the reference.

For an obviousness rejection, the Examiner would have to apply the analysis of Graham v Deere, 383 US 1 (1966), relying (in this instance) upon a single prior art reference and pointing to a supposed motivation for modifying that single reference. It is respectfully submitted that this – even if attempted by the Examiner – remains an insufficient ground for rejection.

The Graham v Deere test for obviousness under 35 USC 103 is the subject matter of Section 2141 et seq in the Manual of Patent Examining Procedure. To briefly restate, the three inquiries, in order, are to determine the applicable prior art, then determine the differences between that art and the claimed invention, and then

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determine whether a person of ordinary skill in the applicable art would know to make the modification necessary to arrive at those differences in view of the prior art applied.

As has been stated by the Court of Appeals for the Federal Circuit in considering matters on appeal from the Board of Appeals within the Patent Office, obviousness is a question of law (the Court citing Graham v Deere), but this determination occurs in the context of a factual inquiry regarding the scope and content of the prior art. This factual inquiry examines what a reference would have taught or suggested to one of ordinary skill in the art at the time of the invention (the Court citing Northern Telecom v Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321). The Court has cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than the obviousness of the claimed invention as a whole as 35 USC 103 requires (citing Hybritech, Inc. v Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81) and against the use of hindsight reconstruction of what is disclosed in a prior art reference (citing Grain Processing Corp. v American Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788). The Court has quoted approvingly from its decision in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, in which it said:

The mere fact that the prior art may [emphasis added] be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

On the latter point, the CAFC has said that the Patent Office, in determining the obviousness of a claimed invention that combines known elements, must determine whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination (citing Lindemann Maschinenfabrik GmbH v American Hoist and Derrick Co., 730 F.2d 1452, 221 USPQ 481).

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It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. See In re Semacker, 702 F.2d 989, 995; 217 USPQ 1, 6 (Fed. Cir. 1983). The reviewing court for the Patent Office requires proof by evidence in order to establish a *prima facie* case when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. See In re Knapp-Monarch Co., 296 F.2d 230, 232; 132 USPQ 6, 8 (CCPA 1961) and In re Cofer, 354 F.2d 664, 668; 148 USPQ 268, 271-272 (CCPA 1966).

No such attempt is made in the Official Action. Indeed, it is Applicants' position that no such attempt can succeed at least because the reference fails to disclose each and every element recited and that recognition of that failing in the prior art has resulted in the absence of any obviousness rejection from the Examiner's argument. It is submitted that this is tantamount to recognition and admission of a patentable invention as defined in the claims under consideration.

For the reasons given above, it is Applicants' position that Claims 9, 13, 21, and 25 define an invention which is patentably distinct from the reference cited, whether applied or not, under the tests of both 35 USC 102 and 35 USC 103. Should the Examiner conclude otherwise, it is respectfully requested that the Examiner's arguments be clarified in any next following Official Action in order that Applicants may more clearly understand the element by element identification (if the rejection is under 35 USC 102) and/or the teaching which suggests obviousness of any combination of references (if the rejection is under 35 USC 103).

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For the record, although indicated as "currently amended," Claims 9, 13, 21, and 25 are of original scope and thus have not been amended for any reason related to the statutory requirements for obtaining a patent. Therefore these claims, and any claim depending therefrom which is not otherwise amended for such reasons, is not subject to the prosecution history estoppel imposed by Festo. See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 122 S. Ct. 1931, 1840, 62 U.S.P.Q.2d 1705, 1712 (2002).

Claim 14

Turning now to claim 14, it is Applicants position that the Kobayashi reference fails to teach or suggest at least the following bold highlighted section of Claim 14.

14. Apparatus comprising:

an image capture device which generates a digital record;

a printer interface which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;

a controller which couples said image capture device and said printer interface, said controller having

a first network interface which connects to an area network for bidirectional exchange of digital data; and

a second network interface which connects to a second network for bidirectional exchange of digital data; and

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a control program stored accessibly to and executable on said controller, said control program when executing enabling a user to select delivery of the digital record to **each and all** of said printer interface, said first network interface, and said second network interface.

Thus, the claim requires that a user be able to select delivery of the digital record to each and all, that is all three, of the printer interface, the first network, and the second network.

As an initial matter, it appears as if the Examiner has parsed the phrase "... each and all of said printer interface, said first network interface, and said second network interface ..." such that the phrase —each and all— only applies to the printer interface. This is seen by Applicants as improper because —each and all— implies a plurality and "... said printer interface ... ," which immediately follows, is singular. Therefore, Applicants see no need to amend the claims to avoid what appears to be the Examiner's parsing of the phrase.

Additionally, the Examiner has cited col. 15 lines 58-65 of Kobayashi as teaching the selection of the destination printers from the list. Even if this assertion were true it does not satisfy the requirements of the claim that a user be able to select delivery of the digital record to each and all, that is all three, of the printer interface, the first network, and the second network.

Notwithstanding, col. 15 lines 58-65 of Kobayashi appears to disclose the selection of a single printer from a plurality of printers. Again, even if this assertion proves to be untrue, the rejection is otherwise lacking as outlined in the prior paragraph.

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Applicants have made a thorough search of Kobayashi and can find no such teaching for the delivery of a digital record to all three destinations specified. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of selection of delivery for a digital record to each and all of (1) the printer interface, (2) the first network, and (3) the second network.

The element by element identity of structure and function necessary for a supportable anticipation rejection are absent not only from the Examiner's argument but also from the reference.

In light of the foregoing, Claim 14 is patentable over Kobayahi or any combination of the cited references at least because the references fail to disclose or suggest these limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Should the Examiner conclude that this claim is unallowable as presented, then it is respectfully requested that the Examiner's arguments be clarified in any next following Official Action in order that Applicants may more clearly understand the element by element identification (if the rejection is under 35 USC 102) and/or the teaching which suggests obviousness of any combination of references (if the rejection is under 35 USC 103).

Claims 15 and 16

Turning now to claims 15 and 16, these claims are believed to be in condition for immediate allowance due to their dependence on independent claim 14 which is believed to be allowable.

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Claims 17

Turning now to claim 17, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 14 which is believed to be allowable.

Additionally, claim 17 is further believed to be patentable for the same reasons given above with respect to claims 9, 13, 21, and 25 in which Kobayashi fails to teach two databases, one non-remote database stored in a memory which is housed with the controller, and a second database which is remote from said controller. Those arguments are incorporated herein by reference.

Claim 26

Turning now to claim 26, this claim is analogous to claim 14 and differs in scope in that, rather than a printer interface, a printer is recited in the combination. Like claim 14, claim 26 allows for the selection "... to each and all of said printer, said first network interface, and said second network interface" Thus, Applicants incorporate herein the arguments made with respect to claim 14 and modify those comments to replace ~~printer~~ for ~~printer interface~~.

Claims 27 and 28

Turning now to claims 27 and 28, these claims are believed to be in condition for immediate allowance due to their dependence on independent claim 26 which is believed to be allowable.

Claim 29

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Turning now to claim 29, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 26 which is believed to be allowable.

Additionally, claim 29 is further believed to be patentable for the same reasons given above with respect to claims 9, 13, 21, and 25 in which Kobayashi fails to teach two databases, one non-remote database stored in a memory which is housed with the controller, and a second database which is remote from said controller. Those arguments are incorporated herein by reference.

Claim 30

Turning now to claim 30, it appears to Applicants that the Examiner has parsed the phrase "... to generate an electronic email message ..." entirely separate from its predecessor "... delivering the digital record to the first network interface ...". The intention of the claim language was to specify that the document be delivered as an embedded document within an email (e.g. as an email attachment). Nevertheless, Applicants find what appears to be the Examiner's reading as reasonable and have amended the claim to more clearly and precisely delineate Applicants' invention. Accordingly, claim 30 has been amended as follows:

2. delivering the digital record to the first network interface to generate as an electronic mail message which contains the digital record;

Applicants respectfully assert that this amendment only explicitly states what was inherent in the unamended claim and as such is not a substantive amendment of the type which would require a new search.

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This amendment is seen by Applicants as merely expressly reciting features inherent in the original claim, and as such, is cosmetic and not subject to the prosecution history estoppel imposed by Festo. Id. For the record, Applicants point out that the Supreme Court in Festo noted that a cosmetic amendment would not narrow the patent's scope and thus would not raise the estoppel. Several decisions by the Federal Circuit have also suggested that amendments that only make express, a recitation of a feature that was already inherent in the original claim, is not a narrowing of the scope of the properly construed claim. TurboCare v. General Electric Co., 264 F.3d 1111 (Fed. Cir. 2001); Bose Corp. v. JBL, Inc., 274 F.3d 1354 (Fed. Cir. 2001) and Interactive Pictures Corp. v. Infinite Pictures, Inc., 274 F.3d 1371 (Fed. Cir. 2001).

Applicants submit that Kobayashi actually fails to disclose, or suggest, at least the following bold highlighted portions of amended Claim 30:

30. A method comprising the steps of:
- capturing a digital record of a document;**
 - executing on a controller a control program which enables a user to **select delivery** of the captured digital record to one of an associated printer, a first network interface, and a second network interface; and
 - performing in accordance to such selection one of:**
 - 1. delivering the digital record to the printer to generate a copy of the document;
 - 2. **delivering the digital record to the first network interface as an electronic mail message which contains the digital record;**

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3. delivering the digital record to the second network interface to generate a facsimile transmission to a remote facsimile receiver.

Thus, amended claim 30 requires the delivery of a digital record, which was captured from a document for which selection was provided as to the first network, through the first network as an email message containing the digital record.

The Examiner cites Kobayashi col. 20 lines 24-25 as meeting the limitations as to email; this assertion is respectfully traversed. Kobayashi col. 20 lines 24-25 (which Applicants believe should read lines 23-24) refers to the emailing of a result and not of emailing the digital record itself (that is, the document, the data). Email is also mentioned for emailing results in Kobayashi in various instances including col. 19 lines 31-33, col. 21 lines 19-21, and col. 22 lines 21-23. Applicants see no teaching or suggestion of emailing the digital record itself.

The element by element identity of structure and function necessary for a supportable anticipation rejection are absent from the reference. Should the Examiner disagree, it is respectfully requested that the Examiner provide specific pointers to the location in the references of a teaching of delivering a digital record as an email message containing the digital record.

Additionally, support necessary for an obviousness rejection is absent from the the reference at least because the reference fails to disclose each and all of the claim limitations.

For the reasons given above, it is the position of Applicants that Claim 30 defines an invention which is patentably distinct from the reference cited, whether applied or not, under the tests of both 35 USC 102 and 35 USC 103. Should the Examiner

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conclude otherwise, it is respectfully requested that the Examiner's arguments be clarified in any next following Official Action in order that Applicants may more clearly understand the element by element identification (if the rejection is under 35 USC 102) and/or the teaching which suggests obviousness of any combination of references (if the rejection is under 35 USC 103).

Claim 31

With respect to claim 31, this claim is believed to be in condition for immediate allowance due to its dependence on Independent claim 31 which is believed to be allowable.

Claims 32, 34, and 35

Claims 32, 34, and 35 have been amended in the same manner as claim 30 and are believed to be patentable for the same reasons presented above with respect to claim 30. The arguments presented above with respect to claim 30 are hereby incorporated by reference as they apply to claims 32, 34, and 35. Kobayashi fails to provide a teaching of delivering a digital record as an email message containing the digital record. Therefore, these claims are believed to be in condition for immediate allowance.

Claim 33

With respect to claim 33, this claim is believed to be in condition for immediate allowance due to its dependence on independent claim 32 which is believed to be allowable.

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The 35 USC §103 Rejections

Claims 31 and 33 stand rejected under 35 USC Section 103(a) over Kobayashi in view of U.S. Patent 6,266,150 to Brossman et al. These rejections have been considered but are considered moot in light of the arguments for patentability set forth above with respect to claims 31 and 33.

New Claims

New Claims 36 and 37 are believed to be patentable and not raise new issues which would require a new search and are thus believed to be in condition for immediate allowance because they include limitations which have already been before the examiner. Using claim 36 as an example, Applicants present below, in bold highlighted text, limitations which are currently before the Examiner and which Applicants believe place claims 36 and 37 in condition for allowance:

36 (New). Apparatus comprising:

an image capture device which generates a digital record;

a printer interface which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;

a controller which couples said image capture device and said printer interface, said controller having

a first network interface which connects to an area network for bidirectional exchange of digital data; and

a second network interface which connects to a second network for bidirectional exchange of digital

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data;

a control program stored accessibly to and executable on said controller, said control program when executing enabling a user to select delivery of the digital record to each and all of (1) said printer interface, (2) said first network interface as an electronic mail message which contains the digital record, and (3) said second network interface, wherein the digital record is generated once by said image capture device for the delivery of the digital record through each and all of said printer interface, said first network interface, and said second network interface; and

a memory coupled to and housed with said controller; said control program when executing on said controller further enabling a user to store a first database of address information in said memory and to selectively access one of said first database of address information stored in said memory and a second database of address information stored remotely from said controller and accessible through said first network interface, wherein one of said first and second databases contains email addresses as data.

Applicants assert that no new matter has been added in newly added claims 36 and 37.

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Request to Proceed to Allowance

For each and all of the reasons set forth above, and as Applicants believe each and all of Examiner's rejections and or objections have been traversed or rendered moot, Applicants respectfully request that this response be considered, entered, and a timely notice of allowance be issued.

The Examiner is urged to call the undersigned at the below-listed telephone number if, in the Examiner's opinion, such a phone conference would expedite or aid in the prosecution of this application.

Respectfully Submitted,



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